

## **I. REMARKS**

This Pre-Prosecution Amendment is filed to establish a continuation application of Applicant's U.S. Patent Application Serial No. 09/933,229, which was filed on August 20, 2001, and which is a continuation-in-part of Application Serial No. 29/145,604, filed July 25, 2001 and now issued to Applicant as U.S. Patent No. D457,972. The present application is filed for the purposes of provoking an interference with U.S. Patent No. 6,539,680 to Kunz et al. (the "`680 patent").

The originally filed claims 1-30 have been cancelled, and the originally filed specification has been amended only to reflect a new title and to establish the above discussed priority information. For the Examiner's reference, a copy of the originally filed specification for the 09/933,229 application is provided, as published at U.S. Pub. No. US2003/0033770, along with a copy of the Kunz `680 patent.

Claims 31-36 are newly added. Claims 31-34 have been, in substance, copied from claims 1-4 of the Kunz `680 patent, which was filed on September 28, 2001 and issued on April 1, 2003. The term "corner" has been substituted for the `680 patent term "nose," the term "flap" substituted for "wing," the term "flange" substituted for "leg" and the term "the" for the term "said." The `680 patent is a continuation-in-part of Kunz's U.S. Patent No. 6,295,776 (the "`776 patent") (also provided), which was filed on May 17, 2000 and issued on October 2, 2001. Herein, it is requested that an interference be declared allowing Applicant to demonstrate entitlement to the subject matter recited in claims 1-4 of Kunz's `680 patent.

The Kunz `680 patent does not include any method claims. However, Applicant's newly added claims 35-36 have been added to further refine and develop, in method format, the invention recited in Applicant's new claims 31-34, and in claims 1-4 of the `680 patent.

Applicant requests that the interfering subject matter be identified by the following single count: "A drywall trim device comprising an elongated core having at least one flange terminating in an edge and an elongated paper strip affixed to the core, a portion of the strip extending beyond the edge to define a flap formed with a plurality of spaced apart, uniform depth depressions projecting from its inward face." In the alternative, Applicant requests that the count be defined by the text of Applicant's newly presented Claim 31.

The Kunz `680 patent includes only claims 1-4, which are all directed to the subject matter of the proposed count. Claim 1 is an independent claim, with Claims 2-4 depending therefrom. As described above, these claims have been copied in substance into Applicant's present application at new Claims 31-34. Arguments demonstrating Applicant's entitlement to the subject matter recited in Claims 1-4 of Kunz's `680 patent are presented below.

## **II. ARGUMENTS**

### **A. Support in Applicant's Disclosure**

Applicant respectfully submits that new Claims 31-34, along with new method claims 35 and 36, do not introduce new matter into the present application. As required

under 37 C.F.R. § 1.607, there is ample support in Applicant's originally filed specification for their recitation. For example, Applicant shows, in Figs. 1-3, a paper strip 40 affixed to the outward surface of a core 20, which includes at least one leg, or flange 26, projecting from a corner, or nose, portion. The paper strip 40 extends beyond a longitudinal edge 30 of the at least one leg/flange 26 to form a wing or flexible flap 50. A plurality of uniform depth, spaced apart corrugations define depressions, or grooves 56 in the exterior surface of the flap/wing 50, and form knurls at 60 (Fig. 3) to project inwardly from the inward face of the flap/wing towards a drywall panel.<sup>1</sup>

Moreover, new claims 31-36 are supported, for example, by the first paragraph of Applicant's "Summary of the Invention" section. The paragraph beginning at line 1, page 6 of Applicant's originally filed specification recites the following (with emphasis added to show correspondence to the count):

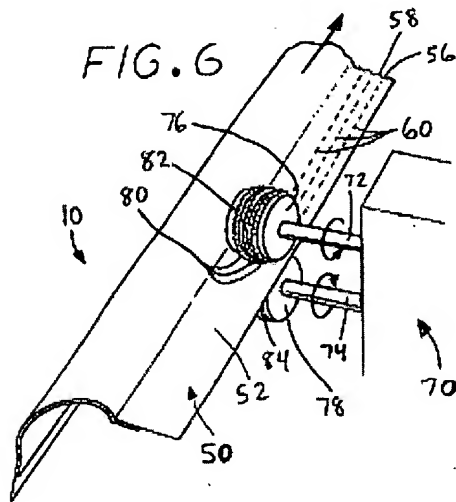
"The present invention provides a drywall bead which is convenient to install and still effective to attractively cover and protect the drywall panel joint. The drywall joint assembly strip device of the present invention is characterized by a lengthwise, longitudinal flexible flap projecting from at least one side and configured with one or more longitudinal grooves and ridges to provide a mechanical anchor in the joint compound when covered therewith."

Also, as shown in Applicant's Figure 6, and disclosed in pages 17-18 of the Applicant's specification as originally filed, Applicant's invention is formed, in part, by

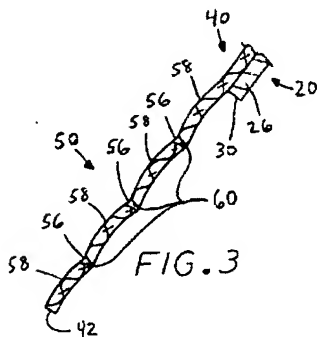
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<sup>1</sup> In an Amendment dated August 12, 2003, Applicant amended the present application to a continuation-in-part claiming priority to Applicant's U.S. Patent No. D457,972, filed on July 25, 2001. Applicant respectfully submits that the same claim scope supported by Figs. 1-3 of the present application is also supported by Figs. 1-2 of Applicant's D457,972 patent.

passing the flap/wing portion 50 of the cover through a roller assembly. The flaps/wings 50 are formed with corrugations to define, on their opposite surfaces, a series of spaced apart, uniform in depth grooves 56 and ridges 58.

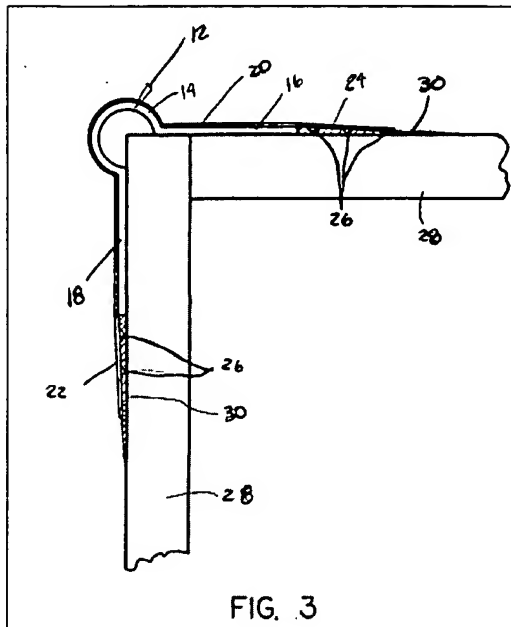


As is more clearly shown in Applicant's Figure 3, the paper is bodily deformed to define laterally spaced apart grooves 56 in the outer surfaces and corresponding knurls or ridges on the inner side to project uniform distances toward the underlying drywall panel.

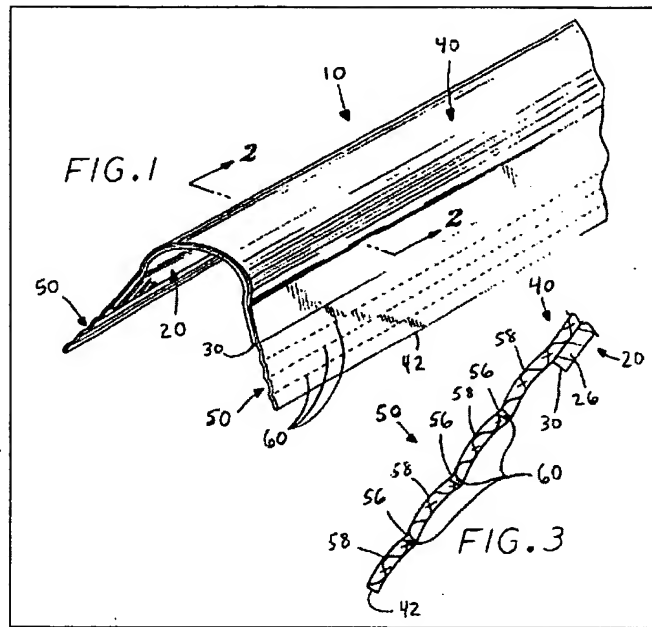


The common subject matter between the Kunz '680 Patent claims and Applicant's invention is especially noteworthy when his Figure 3 is viewed next to Applicant's original Figures 1 and 3:

*Kunz '680 Patent, Fig. 3*



*Applicant's Figs. 1 and 3*



In the Kunz '680 Patent, "the wings have a plurality of dimples [26] projecting from a rearward face." (Kunz '680 Patent, Col. 2, lines 56-57). Kunz's Claim 1 then recites these dimples as "depressions formed therein and projecting from an inward face of the wing." (Kunz '680 Patent, Col. 4, lines 55-56). Figures 1-3 of the Kunz '680 patent show the "dimples" 26, formed in the body of the wings, 22 and 24, as "depressions" which extend into the wing from its exterior face. This is supported by his description of the invention, which states: "This improvement presses an indented profile into the paper . . ." (Kunz '680 Patent, Col. 4, lines 3-4). Kunz's "dimples" (i.e. the "indented profile" formed "into the paper") then project outwardly from the inward face of the wings towards the wallboard 28 to which the device is mounted.

This is the structural equivalent to Applicant's invention, which, as shown for example in Figures 1 and 3, teaches grooves 56 (corresponding to Kunz's "depressions"), formed in the flaps 50 (corresponding to Kunz's "wings"), which generate ridges at 60 projecting from the inward face of the flaps/wings towards the wallboard/drywall to which the device is mounted (Fig. 3). More specifically, the grooves 56 are formed by deforming the body of a flap to generate "depressions" in its outward surface which result in corresponding ridges on the opposite inward side which project outwardly towards the drywall panel, just as recited by Kunz. As such, the recitations of new Claims 31-36 are fully supported by Applicant's specification.

**B. Applicant is Entitled to a Judgment of Priority**

As required under 37 C.R.F. § 1.608, Applicant also respectfully submits that he is *prima facie* entitled to a judgment of priority to the invention recited in Claims 1-4 of the Kunz '680 patent.

The present application is a continuation of copending U.S. Patent Application Serial No. 09/933,229 ("the '229 Application"), which was filed by Applicant on **August 20, 2001**. In an Amendment dated August 12, 2003, the '229 Application was amended to claim priority as a continuation-in-part to Applicant's U.S. Design Patent No. D457,972, entitled Curved Drywall Bead with Perforated Flaps, which was filed on July 25, 2001 and thereafter issued on May 28, 2002. Therefore, the priority date for Applicant's invention is, **July 25, 2001**.

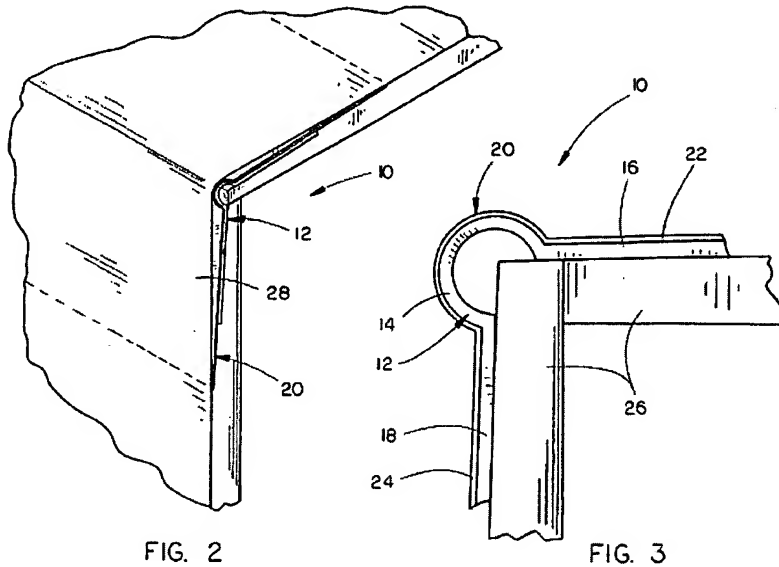
U.S. Patent Number 6,539,680 to Kunz was filed on **September 28, 2001**, one month after the August 20, 2001 filing date of Applicant's parent `229 Application, and two months after its priority date of July 25, 2001.

The `680 patent is a continuation-in-part of Kunz's 6,295,776 patent ("`776 patent"), filed on May 17, 2000. However, Claims 1-4 of the `680 patent are not entitled to this earlier priority date because they are directed to subject matter added in the `680 patent that was not present in the `776 patent. Specifically, while the `776 patent *does disclose* an elongated core formed with flanges and a cover strip projecting beyond the extent of the flanges to form wings (see e.g. Kunz `776 patent, Col. 2, lines 47-62), *it does not disclose* dimples or depressions formed in the body of the wings and configured to project from their inward face.

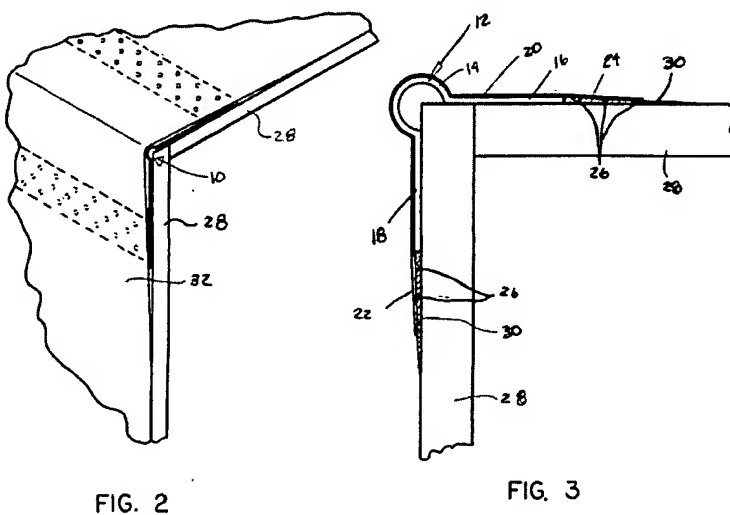
Rather, Kunz's `680 Patent adds the disclosure necessary to support this last aspect of both his `680 invention and Applicant's proposed interference count. Both the disclosure of the `776 patent and the language of its claims make no mention of forming the wings of the cover strip with depressions to project from an inward face. Any possible supporting disclosure for this aspect of the invention comes solely from the `680 patent, which added disclosure relating to "dimples" or "depressions" formed in the paper covering strip that was not present in the `776 patent. (See e.g. Kunz `680 patent, Col. 2, lines 54-57; Col. 3, lines 34-39; Col. 4, lines 1-29; Claims 1-4 Col. 4, lines 44-65).

A side by side comparison of Figs. 2 and 3 of the Kunz `680 CIP patent, with Figs. 2 and 3 of the Kunz `776 parent patent, reveals that any structure that could arguably be said to be "dimples" or "depressions" was first added by Kunz in the `680 patent, and is

not entitled to the priority date of his '776 patent. For example, in Fig. 3 of the '680 patent, Kunz's disclosed "dimples" or "depressions" are depicted at element number 26: However, in the Figures for the '776 patent, e.g. Fig. 3, element number 26 corresponds to the wallboard to which the overall corner bead device is mounted.



***Kunz '776 Patent, Figs. 2-3 (filed May 17, 2000) ("26" = "Wallboard")***





**Kunz '680 Patent, Figs. 2-3 (filed September 28, 2001) ("26" = "dimples"; "28" = "wallboard")**

Therefore, the disclosure of the '680 patent supporting Kunz's claim 1 language reciting "a plurality of spaced-apart, uniform-depth depressions formed therein and projecting from an inward face of the wing" is new to the '680 patent and is not entitled to the priority date of the '776 patent. As such, the disclosure of the '680 patent pertaining to Applicant's proposed interference count is entitled to a priority date only as of the filing date of the '680 patent, i.e. **September 28, 2001**.

This September 28, 2001 date is one month after the **August 20, 2001** filing date of Applicant's '229 Application, and two months after its priority date of **July 25, 2001**. Accordingly, Applicant respectfully submits that he has made a *prima facie* showing of entitlement to a judgment of priority over Claims 1-4 of the Kunz '680 patent.

### **C. Claims 31-36 Are Allowable**

Claims 31-34 have been, in substance, copied from Claims 1-4 of the issued Kunz '680 Patent. As such, Claims 31-34 are believed to be allowable under Applicant's invention, and may serve as the proper basis for the Examiner to propose an interference. Claims 34-35 generally recite, in method format, the substance of apparatus claims 31-34, and are therefore also believed to be allowable. Moreover, Applicant submits that there are no other concerns or deficiencies, such as for example under 35 U.S.C. §§ 102, 103, 112 or 135, which would render Claims 31-36 unpatentable.

In the most recent Office Action received in the prosecution of Applicant's copending U.S. Patent Application Serial No. 09/933,229 ("`229 Application"), the parent to the present application, the Examiner has cited U.S. Patent Nos. 6,295,776 to Kunz ("Kunz"), Re. 34,547 to Weldy ("Weldy"), 2,012,203 to Peterson ("Peterson") and 1,586,018 to Westberg ("Westberg") (all provided herewith), asserting that they combine to render the parent `229 Application's claims obvious. Applicant respectfully submits that these references, whether viewed individually or in combination, fail to disclose the inventive aspect of Claim 31 of the present application (and Claim 1 of the Kunz `680 patent) pertaining to a paper flap formed with a plurality of spaced-apart, uniform-depth depressions projecting from its inward face.

**1. Kunz (U.S. Patent No. 6,295,776) (parent to Kunz `680 Patent)**

As set forth in detail above, the Kunz `776 patent does not disclose dimples or depressions formed in the body of the wings and configured to project from their inward face. Had it been obvious for Kunz to include such a construction in his device, he would have done so at the time of filing the `776 patent, rather than adding disclosure to this effect in his CIP `680 patent (filed after Applicant's `229 Application).

**2. Weldy (U.S. Patent No. Re. 34,547)**

Weldy is formed from a single, extruded strip of plastic and may be categorized as a "nail on" type corner bead by, for example, Fig. 2, which shows nails 16 that secure the strip in place (see also Column 3, lines 21-24: "nails 16 are hammered directly through the flanges 14 and through the drywall 18 into the wooden stud 20 . . ."). Accordingly, Weldy does not contemplate a paper strip affixed to an outward face of a core strip of a

tape-on drywall accessory, as recited in Claim 31. In fact, Weldy recognizes the shortcomings of corner bead core strips, such as his, that are not covered by a paper strip in that he perceives that a primer 28 will be needed to "help the paint and mud bond to the strip." (Column 3, lines 56-58).

Nor does Weldy contemplate that such a strip be formed with a fiber flap having uniform-depth depressions formed therein and projecting from an inward face of the flap, as recited in Claim 31. Rather, Weldy only contemplates that his "flanges can be striated as shown at 24 on their surface which will face outwardly . . ." (Column 3, lines 34-36) (emphasis added).

### **3. Peterson (U.S. Patent No. 2,012,203)**

The Peterson patent is directed to lath and plaster construction, not a tape-on drywall accessory. Peterson discloses a metal expansion joint to be in direct contact with a vertical corner post and to be nailed in overlying relationship positioned directly on the outside surface of lathing. As shown in his Figure 1, Peterson does not contemplate a tape-on drywall accessory having a paper strip affixed to an outward face of a core strip, but rather discloses a single piece, unitary bead which is "pressed or stamped from a sheet metal blank . . ." (Column 1, lines 19-20). He makes no mention of a paper strip for covering this single metal sheet.

Also, Peterson's bead is configured such that outwardly projecting convergent flanges, 5 and 8, and rolled ribs 7 act as dividers defining respective vertical breaks in the overlying plaster to provide for springiness and flexibility and to allow for shifting and shrinkage in the plaster (see e.g. Column 1, lines 54-58). Consequently, it is apparent

that Peterson's construction and objectives are far different from those of Kunz or Applicant. Therefore, Peterson cannot be said to contemplate a paper strip forming a flap having depressions formed therein and projecting from an inward face of the flap, as recited in Claim 31.

#### **4. Westberg (U.S. Patent No. 1,586,018)**

Westberg is also not directed to a tape-on drywall accessory, but rather, is only directed to the underlying plaster board. Westberg discloses a plaster board 1, covered respectively on its top and bottom surfaces with paper coverings 2 and 3 (Column 1, lines 30-33), and teaches that indentations 7 and projections 8 are formed on paper covering the "outer or plaster-receiving side 2" of his wallboard. (Column 2, lines 48-50; Figures 1-3) (emphasis added). As shown in detail in Westberg's Figures 1 and 3, the paper covering of the opposite or inner side 3 of his wallboard is not formed with any such indentations and projections, but is planar.

Westberg's plaster board cannot be said to suggest constructing a tape-on drywall accessory having a paper strip affixed to the outer surface of a core strip and extending transversely beyond a flange of the core strip to form a flap. Moreover, Westberg's indentations and projections, formed in the paper covering the outer side of his plaster board, cannot be equated to depressions formed to project from the inward face of such a flap, as recited in Claim 31.

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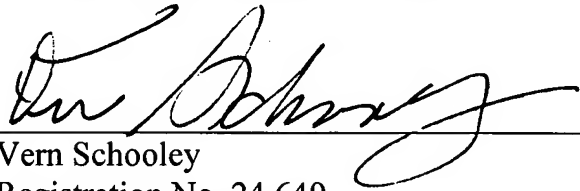
### III. CONCLUSION

Applicant submits that the present Pre-Prosecution Amendment satisfies all of the pre-requisites of 37 C.F.R. §§ 1.607 and 1.608, and respectfully requests that the Examiner declare an interference as set forth above. Applicant has made an important invention to which he has priority, and the scope of that invention encompasses Claims 1-4 of the Kunz '680 patent.

In the event the Examiner should not be in agreement, it is requested that he contact the undersigned attorney to discuss revisions that should be made to the claims or to the text of this Amendment to satisfy any unfulfilled interference requirements.

Respectfully submitted,

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